

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY S. MENDOLIA

Appeal No. 2002-1333
Application 08/880,648

ON BRIEF

Before BARRETT, JERRY SMITH, and DIXON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-10¹.

¹ Pending claims 11-13 were not listed in the examiner's statement of the rejection although claims 11 and 12 were mentioned within the body of the rejection. Appellant's appeal brief states that claims 11-13 were not rejected and, therefore, claims 11-13 are deemed to be allowable [page 8]. Appellant reached this surprising conclusion even though claims 11-13 are identical to other dependent claims rejected by the examiner. Even more surprising is the examiner's statement in the answer that appellant's statement of the status of the claims contained in the brief is correct. At any rate, the uncertainty regarding claims 11-13 is rendered moot in view of our ultimate decision in this case.

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The disclosed invention pertains to a flip style cellular telephone. A particular feature of the invention is that there is an acoustic pipe entirely extending on a peripheral edge of the flip from the free end to the hinged end to carry sound from the free end to the hinged end of the flip.

Representative claim 1 is reproduced as follows:

1. A flip style cellular telephone, comprising:

a main housing;

a flip, pivotally mounted to the main housing by a hinge, the flip having a free end remote from the hinge; and

an acoustic pipe entirely extending on a peripheral edge of the flip from the free end to the hinged end to carry sound from the free end to the hinged end of the flip.

The examiner relies on the following references:

Rabe	5,832,079	Nov. 03, 1998 (filed May 03, 1996)
Thornton	5,915,015	June 22, 1999 (filed Sep. 10, 1996)

Claims 1-10 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Rabe in view of Thornton.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of

obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-10. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 8]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071,

1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

With respect to independent claim 1, the examiner essentially finds that Rabe teaches the claimed invention except that Rabe does not disclose that the acoustic channel extends entirely along one of the peripheral edges of the flip. The examiner notes, however, that Rabe discloses that the cavity can be made in "other shapes and types." The examiner cites Thornton as teaching a triangular shaped acoustic pipe in a flip member of a portable telephone. The examiner asserts that although the cavity of Thornton does not extend completely along the edge of the flip, there is no functional distinction between the Thornton cavity and one in which the outer edge of the cavity is disposed entirely along a peripheral edge of the flip. The examiner finds that it would have been obvious to the artisan to incorporate the acoustic pipe of Thornton into the flip of Rabe and to modify the pipe such that the cavity is disposed entirely along the peripheral edge of the flip [answer, pages 3-4].

Appellant argues that the examiner has failed to point to specific information in either reference which would suggest

combining them. As such, appellant argues that there are no findings to support the examiner's combination. Appellant argues that the acoustic horn of Rabe modified into the shape of a right triangle as taught by Thornton does not teach an acoustic pipe or an acoustic pipe that entirely extends along the perimeter of the flip. Appellant asserts that the flared cavities of Rabe and Thornton are not acoustic pipes and that the differing geometry of these horns prevents them from being entirely disposed along the peripheral edge of the flip. Finally, appellant argues that there is no requirement that the claimed invention have a functional advantage over the prior art [brief, pages 8-11].

The examiner responds that the triangular shaped cavity of Thornton does reside along the edge of one side of the flip although it is a small angle from the entire edge. The examiner also notes that the right triangle shaped cavity would have been obvious over the triangular shape taught by Thornton. The examiner also notes that the acoustic cavities taught by Rabe and Thornton meet the definition of an acoustic pipe as defined within appellant's own specification. Finally, the examiner reaffirms his position that a right triangle shaped cavity would extend along the entire edge of the flip as claimed [answer, pages 6-10].

Appellant responds that the examiner has admitted that the acoustic cavities of Rabe and Thornton do not entirely extend

along one of the peripheral edges of the flip. Appellant argues that the examiner has provided no factual basis for his opinion that it would have been obvious to the artisan to modify the shape of the acoustic cavities taught by Rabe and Thornton [reply brief].

We will not sustain the examiner's rejection of claims 1-10 or of pending dependent claims 11-13. We agree with appellant that the examiner's original rejection failed to provide any legitimate rationale for combining the teachings of Rabe and Thornton and, therefore, failed to establish a prima facie case of obviousness. In the response to arguments section of the answer, the examiner has essentially made three findings upon which the rejection is now based. First, the examiner finds that it would have been obvious to the artisan to modify the triangular acoustic channel of Thornton to have a right triangle shape. Second, the examiner finds that it would have been obvious to the artisan to replace the acoustic channel disclosed by Rabe with the right triangle shape of the modified acoustic horn of Thornton. Third, the examiner finds that the resulting modifications of the first two findings result in the acoustic channel being an acoustic pipe which entirely extends on a peripheral edge of the flip as claimed.

We are unable to agree with the examiner's finding that the applied prior art teaches use of a right triangle as the acoustic

channel. Rabe and Thornton both teach an acoustic channel in the form of a horn whose flared end is at the middle of the free edge of the flip, and whose narrow end goes to one side of the hinged end of the flip. Neither reference teaches a right triangle or a right triangle entirely on a peripheral edge of the flip. The examiner relies on the very general teaching of Rabe that the acoustic horn can have other shapes and types, but this very general suggestion does not necessarily suggest a right triangle. The examiner has not identified any motivation for the artisan to change the acoustic horn of Rabe or Thornton to be in the shape of a right triangle and to place it so that its edge entirely extends on a peripheral edge of the flip. In fact, the only rationale we can see for modifying the acoustic horns of Rabe or Thornton to be in the shape of a right triangle and to be positioned along the edge of the flip would be to recreate the claimed invention in hindsight. Such hindsight modification of the applied prior art, however, is prohibited.

In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-10 (or 13) is reversed.

REVERSED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Lee E. Barnett

LEE E.BARRETT
Administrative Patent Judge

JOSEPH L. DIXON

JOSEPH L. DIXON
Administrative Patent Judge

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